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OFFICE OF PETITIONS

In re Application of :
Claire B. Bass :
Application Number: 10/806082 : DECISION ON PETITION
Filing Date: 03/22/2004 :
Attorney Docket Number: SCF-87 :

This is a decision on the "PETITION UNDER SECTION 37 CFR 1.47," filed on March 12, 2009, which is treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR 1.131 in that it requires that a declaration filed thereunder by signed by the sole inventor.¹

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183."

This application was filed on March 22, 2004. On July 29, 2004, a declaration under 37 CFR 1.63 was filed, naming Claire B. Bass as the sole inventor.

On December 12, 2007, a final Office action was mailed, setting a three (3) month period for reply.

On April 14, 2008, a Request for Continued Examination (RCE), submission under 37 CFR 1.114, a petition for a one (1) month

¹ Once an application has received a fully executed oath or declaration under 37 CFR 1.63 and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. See MPEP 603.

extension of time, and a petition styled under 37 CFR 1.47(a), and declaration under 37 CFR 1.131 signed on behalf of the non-signing sole inventor by the assignee, was filed.

On November 12, 2008, a non-final Office action was mailed, stating, *inter alia*, that the declaration under 37 CFR 1.131 was improper.

In response, on March 12, 2009, the subject petition paper was filed, accompanied by a one (1) month extension of time.

Petitioners state that the declaration under 37 CFR 1.131 was sent to the non-signing inventor by email, but that no response was received.

At the outset, although the petition paper filed on March 12, 2009,² states that it is signed by an officer of the assignee of record, petitioners have not provided the statement in accordance with 37 CFR 3.73(b). Further, the name of the assignee corporation has not been provided.

37 CFR 1.33(b) requires that papers filed in an application must be signed by (1) A patent practitioner of record appointed in compliance with § 1.32(b); (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34; (3) An assignee as provided for under § 3.71(b) of this chapter; or (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

There is no requirement for a showing under 37 CFR 1.47, as noted above. This application bears an original Declaration executed by the sole inventor, and thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

² A petition styled under 37 CFR 1.47, properly signed by petitioner's registered patent practitioner, was filed on April 14, 2008.

Petitioners state that the declaration was sent by email to the non-signing inventor, but that no response was received. Petitioners further state that the inventor was contacted by telephone, and that her email address was confirmed.

The transmission of documents via Email, while a common practice, can be problematic. Transmission and receipt of documents-whether in image, word-processing, spreadsheet or other form-can be effected by differences in software generation between the sender and recipient(s), and other interferences include but are not limited to sender's and recipient's Internet service provider's (ISP) and/or office/personal security firewall systems.

Thus, in the absence of an express statement from a non-signing inventor(s) that he/she/they have received, opened and read a document, unlike a printed page in the language of the recipient there is as of this writing no basis to presume that an Emailed document was in a form that can be read and comprehended.

In this regard, a copy of the declaration under 37 CFR 1.131 should be sent to the **last known address** of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney.³

Petitioner must further present proof that the inventor refuses to sign the declaration under 37 CFR 1.131. If there is a written refusal, a copy of that written refusal must be provided with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In this regard, it is noted that the affidavit of petitioner's registered patent practitioner, Timothy A. Cassidy, states that the non-signing inventor was contacted by telephone by Scott Manley. A statement of facts by Scott Manley, the person with first-hand knowledge of the conversations, should be included, describing the conversations with the non-signing inventor.

If repeated efforts to locate the inventor(s) and obtain the declaration under 37 CFR 1.131 are unsuccessful, petitioners will have shown that the inventor(s) has refused to sign the declaration under 37 CFR 1.131.

³ MPEP 409.03(d) (II).

Still further, petitioner must provide proof that the putative assignee has sufficient proprietary interest in the subject matter to justify filing of the application.⁴

In this respect, while a review of Office assignment records show that this application has been assigned to Safety Components Fabric Technologies, Inc., it is unclear whether the person signing the declaration under 37 CFR 1.131 has signed on behalf of the above-named assignee. The renewed petition must state the name of the assignee as well as the name and title of the corporate officer signing on behalf of the assignee.

In this regard, the name of the assignee is not provided, simply that the signer, Mr. Russell M. Robinson, III, is Vice President and Secretary. If he is Vice President and Secretary of named assignee Safety Components Fabric Technologies, Inc., the declaration under 37 CFR 1.131 should so state.

If Mr. Robinson is Vice President and Secretary of a different assignee or party signing on behalf of the non-signing inventor, that party must provide proof of sufficient proprietary interest to sign on behalf of the non-signing inventor.⁵

Lastly, it is noted that \$130.00 was submitted on April 14, 2008 as the petition fee. The fee for a petition under 37 CFR 1.183, however, is \$400.00. The balance due of \$270.00 must be submitted with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571)273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

⁴ MPEP 409.03(f).

⁵ See MPEP 409.03(f).

Telephone inquiries related to this decision should be directed to the undersigned at 571.272.3231.

A handwritten signature in black ink, appearing to read "D Wood", is positioned above the typed name.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions